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| APPLICATION NO.                    | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/807,464                         | 03/22/2004  | Graham Ross          | 018190-340          | 2915             |
| 21839                              | 7590        | 01/11/2005           | EXAMINER            |                  |
| BURNS DOANE SWECKER & MATHIS L L P |             |                      | BARTH, VINCENT P    |                  |
| POST OFFICE BOX 1404               |             |                      | ART UNIT            |                  |
| ALEXANDRIA, VA 22313-1404          |             |                      | PAPER NUMBER        |                  |
|                                    |             |                      | 2877                |                  |

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/807,464

Applicant(s)

ROSS, GRAHAM

Examiner

Vincent P. Barth

Art Unit

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 Mar. 2004 and 26 Aug. 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections under §103 Double Patenting & Basis for Double Patenting Rejection*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 10, 14, 15 and 21 of Ross, U.S. Pat. No. 6,788,406 (7 Sept. 2004).

4. Referring to instant Claims 1-4, 7, 9, 10 and 15, Ross claims a device for inspecting solder connections (i.e., an optical inspection device) with an image receiving unit in the form of a camera (claim 1, col. 9, ln. 55; claim 2, col. 10, ln. 4). Ross does not explicitly disclose that the camera is a CCD camera (as in instant Claim 4), however, those of skill in the art practicing the invention would understand that a common form of camera for such use is a CCD camera. See MPEP §2144.03. Ross claims that the image receiving unit and image transmitting unit are coupled at each end to each other (claim 1, col. 9, lns. 56-58). Ross does not explicitly claim that such transmitting means is elongated, however, the unit would have a certain length as required to transmit the images, and moreover, in view of the drawings therein, those of skill in the art would understand the unit to be elongated. Ross claims that the tip assembly (i.e., implicitly at a distal end, as claimed) is removably coupled to the image transmitting means, including a reflecting device, and that at least one light emitting aperture is disposed adjacent an image receiving aperture (claim 1, col. 9, ln. 58 to col. 10, ln. 2). Ross does not explicitly disclose that the apertures are fixed in diameter, however, the ordinary meaning of the term aperture is an

opening of a fixed diameter, unless stated otherwise. Ross does not claim that the elongated assembly does not contain a lens, however, Ross claims that the transmitting means may comprise fiber optics (claim 14, lns. 43-44), which is a means of transmitting without a lens. In the alternative, MPEP§ 2144.04(A)(II) states that omission of an element and its function is obvious if not desired, citing In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

5. Referring to Claims 5 and 6, Ross claims that the image receiving unit and image transmitting unit are coupled at each end to each other (claim 1, col. 9, lns. 56-58), and that the transmitting means may comprise fiber optics (claim 14, lns. 43-44).

6. Referring to Claim 8, Ross claims that the tip assembly (i.e., implicitly at a distal end, as claimed) is removably coupled to the image transmitting means, including a reflecting device, and that at least one light emitting aperture is disposed adjacent an image receiving aperture (claim 1, col. 9, ln. 58 to col. 10, ln. 2).

7. Referring to Claim 11, Ross claims that the device includes a display device coupled to the image receiving unit (claim 10, col. 10, lns. 28-31).

8. Referring to Claim 12, Ross claims that the tip assembly (i.e., implicitly at a distal end, as claimed) is removably coupled to the image transmitting means (claim 1, col. 9, ln. 58 to col. 10, ln. 2).

9. Referring to Claims 13 and 14, Ross claims that the device may have a second illumination device (claim 21, col. 11, lns. 21-25), and that the second illumination device may comprise a flexible shaft (claim 21, col. 11, lns. 21-25). Ross claims that the illumination means may be in the form of LED's (claim 15, col. 10, ln. 46).

*Comments*

10. Applicant's amendment to the Specification has been reviewed, and will be entered without objection by the Examiner. The subject matter contained therein merely notes that the instant Application is a continuation, and thus does not introduce new matter.

*CONCLUSION*

11. Applicant's Claims 1-15 are rejected based on the reasons set forth above.
12. Any inquiries concerning this communication from the Examiner should be directed to Vincent P. Barth, whose telephone number is 571-272-2410, and who may be ordinarily reached from 9:00 a.m. to 5:30 p.m., Monday through Friday. The fax number for the group before final actions is 703-872-9306.
13. If attempts to reach the Examiner prove unsuccessful, the Examiner's supervisor is Gregory J. Toatley, Jr., who may be reached at 571-272-2800, ext. 77.
14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard A. Rosenberger  
Primary Examiner